

REMARKS

In response to the Office Action dated December 22, 2008, the Assignee respectfully requests continued examination and reconsideration based on the above amendments and on the following remarks.

Claims 1, 3-18, and 20-32 are pending in this application.

Rejection of Claims under § 102 (e)

The Office rejects claims 1 and 3-17 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 7,212,979 to Matz.

Claims 1 and 3-17, though, are not anticipated by *Matz*. These claims recite, or incorporate, many features that are not disclosed or suggested by *Matz*. Independent claim 1, for example, recites “*denying local storage of the clickstream data at the viewer appliance.*” Support may be found at least at page 5, lines 16-18 of the as-filed application. Independent claim 9 recites similar features.

Matz does not anticipate these features. *Matz* describes the transmission of viewer actions to a subscriber action database. See U.S. Patent 7,212,979 to Matz at column 6, lines 25-30. *Matz*, however, fails to teach or suggest “*denying local storage of the clickstream data at the viewer appliance.*” The patent to Matz, then, cannot anticipate independent claims 1 and 9.

Claims 1 and 3-17, then, cannot be anticipated by *Matz*. Independent claims 1 and 9 recite features that are not disclosed or suggested by *Matz*. The dependent claims incorporate these same features and recite additional features. Claims 1 and 3-17, then, cannot be anticipated, so the Office is respectfully requested to remove the § 102 (e) rejection of these claims.

Rejection of Claims under § 103 (a)

The Office rejected claims 18 and 20-32 under 35 U.S.C. § 103 (a) as being obvious over *Matz* in view of U.S. Patent Application Publication 2002/0100064 to Ward, *et al.*

The proposed combination of *Matz* with *Ward* teaches away and cannot support a *prima facie* case for obviousness. The M.P.E.P. expressly explains several situations in which a reference teaches away, including when a proposed modification “render[s] the prior art unsatisfactory for its intended purpose” or when the proposed modification “change[s] the principle of operation of a reference.” See M.P.E.P. § 2145 (X)(D). If *Matz* is combined with *Ward*, as the Office proposes, then *Matz*’s principle of operation must be impermissibly changed. The proposed combination of *Matz* with *Ward* cannot support a *prima facie* case for obviousness, so the Office is required to remove the § 103 (a) rejection of these claims.

Matz describes a subscriber-action database. See U.S. Patent 7,212,979 to Matz at column 6, lines 15-16. As a subscriber makes viewing choices, the choices are transmitted to the subscriber-action database. See *id.* at column 6, lines 26-30. Each subscriber action, such as “channel up” or “channel down,” is time-stamped. See *id.* at column 6, lines 31-44. A “merge processor” receives various data and “merges the data based upon the date-time attributes.” See *id.* at column 6, lines 45-48.

Ward describes a timing reference for components in a television studio. *Ward* modifies a “program click reference” (or “PCR”) field in an HDTC bitstream. U.S. Patent Application Publication 2002/0100064 to Ward, *et al.* at [0021]. A “PCR stamper” is coupled to a Global Positioning System receiver or a SONET interface. See *id.* at [0022]. **The PCR stamper receives a global time from the GPS receiver and “restamps the PCR fields within each MPEG compliant bitstream such that all the bitstreams contain the time of day generated by the GPS receiver.”** See *id.* at [0022] (emphasis added). The bitstreams are then “organized” into a transport stream and coupled to the SONET interface. See *id.* at [0022]. A SONET

network then distributes the transport stream to the television studios for broadcast. *See id.* at [0022].

The Office should now realize that “impermissible changes” are required. If *Matz* is combined with *Ward*, as the Office proposes, then *Matz*’s principle of operation must be impermissibly changed. *Matz*’s principle of operation, for example, must be changed to include *Ward*’s GPS interface to a GPS system. *Matz*’s principle of operation must also be changed to include *Ward*’s “PCR stamper” that “restamps the PCR fields within each MPEG compliant bitstream such that all the bitstreams contain the time of day generated by the GPS receiver.” *Matz*’s principle of operation must also be changed to couple with *Ward*’s SONET network to distribute transport streams to television studios. Indeed, *Matz*’s description of a set-top box that time-stamps clickstream data must be changed to, somehow, i) interface with a GPS system and to ii) replace a “PCR field” in the clickstream data with the time of day generated by the GPS receiver, as *Ward* teaches.

Matz with *Ward* thus teaches away. If *Matz* is combined with *Ward*, as the Office proposes, then *Matz*’s principle of operation must be impermissibly changed. The patent laws, however, forbid changing a principle of operation to support a *prima facie* case for obviousness. The § 103 (a) rejection, based on a proposed combination of *Matz* with *Ward*, must fail. The Office is required to remove the § 103 (a) rejection of these claims.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 469-2629 or scott@scottzimmerman.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Scott Zimmerman", is written over a light gray circular stamp.

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